

REMARKS

Claims 1–124 are pending in the present application.

Claims 120–124 are withdrawn from consideration.

Claims 1–2, 24, 36–37, 58 and 78 were amended.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 112, Second Paragraph (Definiteness)

Claims 1, 6 and 78 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. This rejection is respectfully traversed.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether the claim as a whole reasonably apprises those skilled in the art of the scope of the claim. MPEP § 2173, p. 2100-199 (8th ed. rev. 1 February 2003).

Claim 1 was objected to as reciting “system” within the preamble of the claim:

Claim 1 recites “system” which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are considered apparatus.

Paper No. 14, page 2. The Office Action is incorrect in that Applicant is under NO obligation to proffer a classification for the claimed invention. Moreover, those skilled in the art would have no particular difficulty determining the subject matter encompassed by claim 1. Claim 1 recites as

elements “a network” and “a real estate facilitator,” each of which refers to an apparatus or device (or element therein) rather than a step or action. Claim 1 is clearly directed to an apparatus rather than to a process or method.

Claim 6 was objected to as reciting “ad hoc”:

Claim 6 is rejected as indefinite for using the term “ad hoc” to describe a particular database. The term “ad hoc” means: for a particular purpose. Since the definition of a database is a collection of data stored on a computer storage medium used for more than one purpose, the term ‘ad hoc’ is confusing and therefore indefinite.

Paper No. 14, page 2. However, the Office Action cites no support for either definition adopted. As used by the specification, an “ad hoc” database is one formed for a particular project (defined by a project requirements specification or “PRS”):

An ad hoc real estate supply database may be formed of entries that are provided by landlords 205 in response to a particular PRS 505. Consequently, an ad hoc real estate supply database is formed responsive to the needs of an individual would-be tenant 115 and by landlords 205 that are interested in meeting those needs.

Specification, page 28, lines 2–7. Thus, even accepting the definitions adopted in the Office Action (which are incorrect), the terms are NOT inconsistent.

Claim 78 has been amended to correct the error identified in the Office Action.

Therefore, the rejection of claims 1, 6 and 78 under 35 U.S.C. § 112, second paragraph has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 1–2, 36–66, 71–75, 100–102 and 114–119 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,313,404 to *Good et al* in view of U.S. Patent No. 5,584,025 to *Keithley et al* and further in view of U.S. Patent No. 6,356,878 to *Walker et al*. Claims 3–8 and 24–25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of U.S. Patent No. 5,974,406 to *Biskidian et al*. Claims 9–12 and 43–44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of U.S. Patent Application Publication No. 2002/0023033 for *Campbell et al*. Claims 26–29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of U.S. Patent No. 6,332,129 to *Walker et al*. Claims 30–35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of U.S. Patent No. 5,987,449 for *Suciu*. Claims 67–70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of U.S. Patent Application Publication No. 2003/008957 for *Olefson*. Claims 76–79 and 87–96 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of U.S. Patent No. 5,918,219 to *Isherwood*. Claims 80–86 and 97–99 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of

U.S. Patent No. 6,574,605 to *Sanders et al.* Claims 103–107 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of U.S. Patent No. 5,698,650 to *McClelland et al.* Claims 103–113 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Good et al* in view of *Keithley et al* and *Walker et al* '878, and further in view of U.S. Patent No. 6,023,687 to *Weatherly et al* and US 6,336,105 to *Conklin et al.* These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-123 (8th ed. rev. 1 February 2003). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142 at p. 2100-124.

Independent claims 1 and 36 each recite both a real estate demand database (i.e., a database of entries specifying, without obligation, desired real estate characteristics, to solicit offers or

proposals) and a real estate supply database (i.e., a database of entries specifying available real estate). Such a feature is not depicted or described by the cited references, taken alone or in combination.

Similarly, independent claims 2 and 58 each recite that the real estate demand database is formed from non-binding specifications detailing, without obligations, desired real estate characteristics to solicit offers or proposals. Such a feature is not depicted or described by the cited references, taken alone or in combination.

The Office Action states:

Walker et al ('878) does disclose demand (col. 1, lines 59), as broadly claimed by applicant.

Paper No. 14, page 16. However, the Office Action fails to specify what meaning is being accorded to "demand." Moreover, *Walker et al* describes only a Conditional Purchase Offers (CPO) database 500 that contains offers binding on the offeror if accepted, and is silent as to non-binding specifications of a desired product or service. In one alternative embodiment, the CPOs may change over time in a buyer-specified manner based on a specific variable or variables, allowing the buyer to effectively simultaneously submit multiple CPOs effective at different times:

As used herein, a variable CPO is a binding offer containing at least one variable condition submitted by a buyer for the purchase of an item, within a buyer-specified price range. As discussed below, the variable CPO may be guaranteed, for example, using a general-purpose financial account, such as a credit or debit account, maintained by a financial institution. Once a seller accepts the offer, the buyer is bound by the conditional purchase offer (CPO) buyer agency system 100 transferring payment from the general-purpose financial account

previously designated by the buyer to the accepting seller (or transferring an indication of the general-purpose account itself to the seller for processing). Thus, even if the buyer ultimately fails to proceed with the transaction following acceptance of the CPO by a seller, the general-purpose account designated by the buyer will be charged the full value or a penalty.

A variable condition contains either a range of values or both an initial value and at least one alternate value therefor. A different buyer-defined price may be specified for each possible combination of conditions. The disclosed conditional purchase offer (CPO) buyer agency system 100 allows a buyer to submit multiple purchase offers at one time. The multiple CPOs may be provided to sellers sequentially or simultaneously. In addition, when purchase offers are provided sequentially, the buyer may control the timing and priority in which the purchase offers are provided to the sellers.

Walker et al, column 5, lines 16–42. However, conditional purchase offer remains binding on the offeror if accepted. Thus, the CPO thus does not reflect demand (i.e., interest in acquiring fungible property or services) based on specified desired characteristics, but instead merely (buyer-specified) guaranteed price-points based on variable conditions. *Walker et al* does not describe or suggest non-binding purchase offers or specifications of desired transaction characteristics. Accordingly, not all features of the claimed invention are depicted or described in the cited references.

Claims 3 and 37 each recite that, upon addition of an entry to the real estate demand database, the specified desired real estate characteristics are automatically compared to entries within a real estate supply database to determine any matches. Such a feature is not depicted or described by the cited references, taken alone or in combination. None of the references depicts or describes both supply and demand databases, or automatically comparing a new entry to either database with entries in the other database to determine any existing matches. *Bisdikian et al* discloses an automated

search system which allows a search to proceed without the user being continuously connected to the search process, and to receive notification of search results by user-selected means. *Bisdikian et al* does NOT teach automatically initiating a search for matches between two databases upon addition of a new entry to one of the two databases, but instead merely teaches a generalized search process. Moreover, none of the references provide a motivation for either combining the respective teachings (a generalized “motivation” based on the teaching of “common” use of different databases in search systems is not sufficient for achieving a particular result) nor modifying the collective teachings to achieve the claimed feature.

Claims 6 and 40 each recite forming an ad hoc database from matches between desired and available real estate that are selected as preferred by the prospective tenant. As noted above, “ad hoc” refers to subject matter concerned with a particular subject, purpose or end. As taught by the specification and explicitly recited in amended independent claim 1, an “ad hoc” real estate supply database is formed based upon responses of landlords to publication of at least one desired real estate characteristic (within a project requirements specification or “PRS”) by the prospective tenant:

An ad hoc real estate supply database may be formed of entries that are provided by landlords 205 in response to a particular PRS 505. Consequently, an ad hoc real estate supply database is formed responsive to the needs of an individual would-be tenant 115 and by landlords 205 that are interested in meeting those needs.

Specification, page 28, lines 2–7. Thus, the real estate supply database contains not simply all real estate available, but available real estate for which the associated landlord has affirmatively expressed an interest in leasing to the prospective tenant. The real estate supply database is therefore

“ad hoc” in the sense that all entries relate to a specific project requirements specification. In the embodiment recited in claim 6 and 40, the ad hoc database is formed by selection of preferred matches to a particular project requirements specification by the prospective tenant. Such a feature is not depicted or described by the cited references, taken alone or in combination. *Good et al* and *Keithley et al* each simply employ a comprehensive database of all available real estate, while *Walker et al* does not depict or describe a database of available products or services.

Claims 9 and 43 each recite sending a request for proposal to each match between a real estate demand database entry and the entries of a real estate supply database selected by the prospective tenant. Such a feature is not depicted or described by the cited references, taken alone or in combination. The cited portion of *Campbell et al* teaches forwarding RFPs to all registered providers found to match the specified financing and/or industry sector, not merely to only those matching service providers selected by the originator.

Claims 10 and 44 recite allowing a prospective tenant to designate primary and secondary proposals from among a plurality of proposals sent by one landlord to the prospective tenant in response to a request for proposal. Such a feature is not depicted or described by the cited references, taken alone or in combination.

Independent claim 24 recites employing both real estate demand and real estate supply databases, and automatically comparing a new demand entry to entries with the supply database to determine matches, then linking the prospective tenant for the new demand entry to each demand

database entry for real estate satisfying the characteristics desired by the prospective tenant. Such a combination of features is not depicted or described by the cited references, taken alone or in combination. As noted above, *Bisdikian et al* merely teaches a generalized “off-line” search process, and does not describe triggering a search of one database upon addition of a new entry to a counterpart database.

Independent claim 26 recites a set of data records or entries each relating to real estate demand by two or more prospective tenants and based upon the real estate characteristics desired by those tenants, each entry in the form of a non-binding specification detailing, without obligation, the desired real estate characteristics in order to solicit offers or proposals. Such a feature is not depicted or described by the cited references, taken alone or in combination. As noted above *Good et al* and *Keithley et al* relate only to supply databases, not demand databases, while *Walker et al* ‘878 describes only binding offers. *Walker et al* ‘129 describes “non-binding” Condition Purchase Offers which (a) create an obligation on the part of the offeror, and include penalties for “reneging”, and (b) are themselves offers, not used to solicit offers. *Walker et al* ‘129, column 9, lines 26-30.

Claims 30, 60 and 62 recites an “ad hoc” supply database as discussed above, generated from combined responses by landlords to publication of a desired real estate attribute by a prospective tenant. Claim 30 recites including only entries within the ad hoc supply database corresponding to landlords affirmatively expressing interest in leasing to the prospective tenant. Such a feature is not depicted or described by the cited references, taken alone or in combination. *Good et al* or *Keithley*

et al describe only comprehensive supply databases, while *Walker et al* does not describe any supply database, or formulating ad hoc databases of product/service descriptions satisfying characteristics specific by the offeror. The phrase “query expression of interest” in *Suciu* refers to the search string (or “expression”) for the query, not an expression of interest in meeting a specified need by parties corresponding to a database entry.

Independent claim 67 recites accepting a critique from a prospective tenant regarding a piece of real estate toured by that prospective tenant and sharing information derived from the critique with another prospective tenant. Such a feature is not depicted or described by the cited references, taken alone or in combination. The cited portion of *Olefson* merely states that “the user will be asked to complete a feedback form asking for questions and comments.” *Olefson* does not specify whether the feedback relates to the program/virtual tour or the property which is “viewed” through the virtual tour. In addition, *Olefson* does not describe sharing information derived from the feedback with other users of the virtual tour.

Independent claim 71 recites enabling electronic access to a plurality of entities each associated with at least one real estate acquisition or outfitting phase, allowing online collaboration of parties involves in the acquisition and outfitting or real estate (i.e., the tenant, landlord, architect, engineer, contractor, etc.). Such a feature is not depicted or described by the cited references, taken alone or in combination.

Independent claim 76 recites providing real estate acquisition and outfitting services at least partially in parallel and on-line. Such a feature is not depicted or described by the cited references, taken alone or in combination. The cited portion of *Isherwood* (Figure 6a) specifically disclaims showing “the time scale of the activities.” *Isherwood*, column 8, lines 24–25. Moreover, Figure 6b, which is described as representing the same schedule as Figure 6a (*Isherwood*, column 8, lines 63–65), depicts the activities as sequential rather than at least partially in parallel.

Independent claim 78 recites providing real estate acquisition and outfitting services within a completion time reduced at least partially by use of an on-line mechanism. Such a feature is not depicted or described by the cited references, taken alone or in combination. The cited portion of *Isherwood* (column 4, lines 12–20) makes no mention of reducing completion time for job estimating.

Independent claim 80 recites determining when electronic information relating to a first real estate outfitting phase has been changed and, upon detecting such change, notifying an entity corresponding to a second real estate outfitting phase. Such a feature is not depicted or described by the cited references, taken alone or in combination. The cited portion of *Sanders et al* (column 29, lines 13–20) does not relate to communicating a change to one phase of a project to a party associated with another phase, but simply to updated remote portions of a distributed enterprise management system.

Independent claim 87 recites electronically sharing information relating to a potential real estate transaction so that a real estate phase of the potential transaction and another acquisition and outfitting phase (e.g., physical design analysis phase 1230, due diligence phase 1235, design phase 1240/1245, bidding/estimation/value engineering phase 1250, construction phase 1255, and relocation phase 1260) is performed at least partially overlapping in time with the real estate phase. Such a feature is not depicted or described by the cited references, taken alone or in combination.

Independent claim 97 recites allowing one party to specify real estate outfitting requirements that may be modified by another party, with modifications accessible to the original party and a third party. Such a feature is not depicted or described by the cited references, taken alone or in combination.

Independent claim 100 recites selecting one or more pieces of real estate meeting a criterion of a prospective tenant, sending a request for information to each landlord associated with a selected piece of real estate, receiving responses to the requests from the landlords for review by the prospective tenant. Such a feature is not depicted or described by the cited references, taken alone or in combination.

Independent claim 103 recites a real estate demand database reviewed by a landlord for entries of interest and a request by the landlord for entry into a corresponding transaction. Such a feature is not depicted or described by the cited references, taken alone or in combination.

Independent claim 108 recites automatically handling renewal of a lease about to expire using a demand-driven on-line mechanism. Such a feature is not depicted or described by the cited references, taken alone or in combination.

Independent claim 114 recites combining information regarding a real estate deal from various sources and providing electronic access to such combined information to a plurality of parties, allowing on-line collaboration between the tenant, landlord, architect, engineer, contractor, etc. as described above. Such a feature is not depicted or described by the cited references, taken alone or in combination.

Therefore, the rejection of claims 1–113 under 35 U.S.C. § 103 has been overcome.

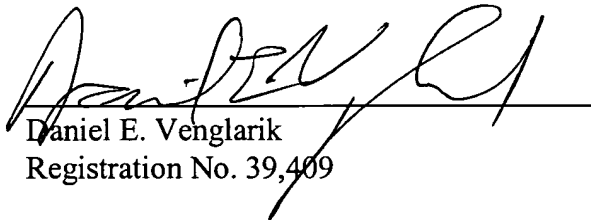
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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